

REMARKS

Claims 1-20 are pending in this application. By this Amendment, claims 10 and 15 are amended. Support for the amendments to claims 10 and 15 can be found in the specification as originally filed, for example, at page 28, lines 4-13, and in original claims 10 and 15. No new matter is added by this amendment.

I. Priority

The Office Action Summary indicates that some of the certified copies of the priority documents of this application have been received, but does not include a listing in the Office Action of certified copies that have not been received. Applicants respectfully submit that a claim for priority and a certified copy of the priority document, Japanese Patent Application No. 2003-185632, were filed in the U.S. Patent and Trademark Office on February 17, 2004. The priority claim and certified copy are viewable on the U.S. Patent Office's Public Patent Application Information Retrieval system. Accordingly, the Examiner is respectfully requested to acknowledge receipt of the certified copy of the priority document in writing.

II. Claim Rejections Under 35 U.S.C. §102**A. Sasaki 370**

The Examiner rejects claims 1-16 and 18-20 under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2003/0044370 to Sasaki et al. (Sasaki 370). Applicants respectfully traverse this rejection.

Sasaki 370 teaches resin powders for dermatological compositions. *See* Sasaki 370, Abstract. The Sasaki 370 resin powders have a Shape Factor SF1 of from 110 to 140, average particle volume in a range of from 2.0-20.0 μm , and a surfaceness index of 2.0 or less. *See* Sasaki 370, [0021]-[0032]. The resin powders may be formed from monomers including styrene and acrylate monomers. *See* Sasaki 370, [0049]. Based on these teachings, the Examiner takes the position that the subject matter of claims 1-16 and 18-20 is anticipated

by Sasaki 370. In particular, the Examiner asserts that the Sasaki 370 resin particles would inherently have the same hydrophobicity as the claimed particles because they are formed from the same polymers, and that the Sasaki 370 particles would satisfy the equations set forth in the claims because the composition, Shape Factor SF1, average particle volume and surfaceness index limitations are met. Applicants respectfully disagree.

Independent claim 1 sets forth, in pertinent part, a “resin powder for a cosmetic comprising particles containing a resin, wherein ... when seen from a direction in which a projected area of the particle to a plane is maximum, the particles are satisfactory with the following equations: $0.5 < b/a < 1$ [,] $0.4 < c/b < 0.8$ [,] where a is a major axis of each particle; b is a minor axis of each particle; and c is a thickness of each particle.” Claims 2-14 depend, directly or indirectly, from claim 1 and incorporate all of the limitations thereof. Independent claim 15 sets forth a process for preparing a resin powder in which the resin powder is defined as in claim 1. Independent claim 16 depends, directly or indirectly, from claim 15 and incorporates all of the limitations thereof. Independent claims 18 and 19 each set forth a cosmetic that comprises a resin powder in which the resin powder is defined as in claim 1. Independent claim 20 depends, directly or indirectly, from claim 19 and incorporates all of the limitations thereof.

The particles set forth in the pending claims have ratios of minor axis to major axis (b/a) and thickness to minor axis (c/b) within specific, defined ranges. Such particles have shapes such as discs and elliptical shapes, such as that of a rugby ball. *See* Specification, page 12, line 23 – page 13, line 4. When the resin particles fall within the claimed ranges, cosmetics including these particles have improved spreadability. *See* Specification, page 14, line 18 – page 15, line 6.

In order to obtain particles meeting the claimed (b/a) and (c/b) ratio range limitations, the resin particles are subjected to a reshaping treatment, as described in the Specification.

See Specification, page 28, line 4 – page 31, line 1. As shown in Preparation Examples 1 and 2, including reshaping treatments in the particle preparation allows particles having the claimed (b/a) and (c/b) ratio range limitations to be met. See Specification, page 41, line 4 – page 47, line 23.

In contrast, Sasaki 370 does not teach resin particles or methods of producing resin particles, subjected to a reshaping treatment. See Sasaki 370, [0052]-[0055]. Thus, the resin particles produced in the Sasaki 370 Examples, which do not include a reshaping treatment step, would not meet the claimed (b/a) and (c/b) ratio range limitations. Rather, the resin particles of Sasaki 370 would have (b/a) and (c/b) ratios similar to those of Preparation Examples 3-5 in the Specification, and at least one of the ratios, (b/a) or (c/b), is outside of the claimed ranges.

Because the resin particles of Sasaki 370 would not satisfy at least the limitation of independent claims 1, 15, 18 and 19 that “when seen from a direction in which a projected area of the particle to a plane is maximum, the particles are satisfactory with the following equations: $0.5 < b/a < 1$ [,] $0.4 < c/b < 0.8$ [,] where a is a major axis of each particle; b is a minor axis of each particle; and c is a thickness of each particle,” Applicants respectfully submit that pending claims 1-16 and 18-20 are patentable over Sasaki 370.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Sasaki 649

The Examiner rejects claims 1-16 and 18 under 35 U.S.C. §102(e) over U.S. Patent No. 6,893,649 to Sasaki et al. (Sasaki 649). Applicants respectfully traverse this rejection.

Independent claims 1, 15 and 18 are as set forth above. Claims 2-14 and 16 depend, directly or indirectly, from and incorporate all of the limitations of these independent claims, as discussed above.

Sasaki 649 teaches solid powder cosmetics. *See* Sasaki 649, Abstract. The Sasaki 649 cosmetics include spherical resin particles having average particle volume size in a range of from 2.0-20.0 μm , a Shape Factor SF1 of from 110 to 140, and a superficial index value of 2.0 or less. *See* Sasaki 649, col. 2, line 45 – col. 3, line 13. The resin particles may be formed acrylic copolymers. *See* Sasaki 649, col. 3, lines 6-8. Based on these teachings, the Examiner takes the position that the subject matter of claims 1-16 and 18 is anticipated by Sasaki 649. In particular, the Examiner asserts that the Sasaki 649 resin particles would inherently have the same hydrophobicity as the claimed particles because they are formed from the same polymers, and that the Sasaki 649 particles would satisfy the equations set forth in the claims because the composition, Shape Factor SF1, average particle volume size and surfaceness index limitations are met. Applicants respectfully disagree.

As discussed above with respect to Sasaki 370, the claimed particles have ratios of minor axis to major axis (b/a) and thickness to minor axis (c/b) within specific, defined ranges, and the particles are subjected to a reshaping treatment, as described in the specification, to achieve these ratios. *See* Specification, page 28, line 4 – page 31, line 1.

Like Sasaki 370, Sasaki 649 does not resin particles or methods of producing resin particles, subjected to a reshaping treatment. *See* Sasaki 649, col. 7, line 31 – col. 8, line 25. Thus, the resin particles produced in the Sasaki 649 Examples, which do not include a reshaping treatment step, would not meet the claimed (b/a) and (c/b) ratio range limitations. Rather, the resin particles of Sasaki 649 would have (b/a) and (c/b) ratios similar to those of Preparation Examples 3-5 in the Specification, and at least one of the ratios, (b/a) or (c/b), is outside of the claimed ranges.

Because the resin particles of Sasaki 649 would not satisfy at least the limitation of independent claims 1, 15 and 18 that “when seen from a direction in which a projected area of the particle to a plane is maximum, the particles are satisfactory with the following equations:

0.5 < b/a < 1 [,] 0.4 < c/b < 0.8 [,] where a is a major axis of each particle; b is a minor axis of each particle; and c is a thickness of each particle,” Applicants respectfully submit that pending claims 1-16 and 18 are patentable over Sasaki 649.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Claim Rejections Under 35 U.S.C. §103

The Examiner rejects claims 15-17 under 35 U.S.C. §103(a) over U.S. Patent No. 7,005,480 to Kinsho et al. Applicants respectfully traverse this rejection.

Kinsho teaches resin dispersions having uniform particle diameters and methods for producing resin dispersions. *See* Kinsho, Abstract. In the Kinsho method, resin particles may be produced by emulsion polymerization and may be dispersed using a Nanomizer. *See* Kinsho, col. 12, line 30 – col. 13, line 41; col. 19, line 50 – col. 20, line 7. Based on these teachings, the Examiner takes the position that the subject matter of claims 15-17 would have been obvious over Kinsho. Applicants respectfully disagree.

Independent claim 15 sets forth, in pertinent part, a "process for preparing a resin powder for cosmetic including particles containing a resin, comprising a step of producing the particles by emulsion polymerization and a step of subjecting the particles to a reshaping treatment, wherein ... when seen from a direction in which a projected area of the particle to a plane is maximum, the particles are satisfactory with the following equations: $0.5 < b/a < 1$ [,] $0.4 < c/b < 0.8$ [,] where a is a major axis of each particle; b is a minor axis of each particle; and c is a thickness of each particle." Claims 16 and 17 depend from and incorporate all of the limitations of independent claim 15.

The step of “subjecting the particles to a reshaping treatment” allows particles satisfying the claimed (b/a) and (c/b) ratio range limitations to be obtained, as discussed above. However, Kinsho does not teach or even suggest subjecting resin particles to a

reshaping treatment. *See generally* Kinsho. Because Kinsho does not teach a reshaping treatment step, and does not include any motivation or suggestion to reshape its resin particles, Kinsho does not teach or suggest at least the claimed step of “subjecting the particles to a reshaping treatment.”

Because Kinsho does not teach or suggest methods that include a step of “subjecting the particles to a reshaping treatment,” as in independent claim 15, Kinsho would have rendered pending claims 15-17 obvious. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

IV. Double Patenting

The Examiner rejects claims 1-16 and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-9, 15 and 16 of Sasaki 649. The Examiner also provisionally rejects claims 1-16 and 18-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5 and 7 of co-pending U.S. Patent Application No. 10/015,611, which published as Sasaki 370.

As discussed above, neither Sasaki reference teaches resin particles that would satisfy the claimed (b/a) and (c/b) ratio range limitations. Such particles are not even suggested by the references, as neither Sasaki reference includes any motivation or suggestion to modify their resin particles with a reshaping treatment.

Because neither Sasaki 649 nor Sasaki 370 teaches or suggests resin particles that would satisfy at least the limitation of independent claims 1, 15 and 18 that “when seen from a direction in which a projected area of the particle to a plane is maximum, the particles are satisfactory with the following equations: $0.5 < b/a < 1$ [,] $0.4 < c/b < 0.8$ [,] where a is a major axis of each particle; b is a minor axis of each particle; and c is a thickness of each particle,” neither Sasaki 649 nor Sasaki 370 would have rendered pending claims 1-16 and 18

obvious. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Petition for Extension of Time

Date: August 18, 2006

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